



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/676,249	09/29/2000	Kendall Wayne King	PC10555A	1131

7590 07/19/2004  
Paul H Ginsburg  
Pfizer Inc  
235 East 42nd Street  
20th Floor  
New York, NY 10017-5755

EXAMINER

SWARTZ, RODNEY P

ART UNIT	PAPER NUMBER
----------	--------------

1645

DATE MAILED: 07/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

8M

## Office Action Summary

### Application No.

09/676,249

### Applicant(s)

KING ET AL.

### Examiner

Rodney P. Swartz, Ph.D.

### Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17February2004, 6February2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 18-33 is/are pending in the application.
- 4a) Of the above claim(s) 18-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date, \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: SEQ LISTINGS 1/01, 2/03, 5/03.

### **DETAILED ACTION**

1. Applicants' Status Inquiry, received 17February2004, is acknowledged. Upon inquiry, the examiner found that the application was administratively placed into the wrong status and therefore did not appear on the examiner's response docket. The error has been corrected and an action follows.
2. Applicants' Response to Office Action, received 6February2003, is acknowledged. Claims 1 and 11 have been amended.
3. Claims 1-11 and 18-33 are pending. Claims 18-33 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.
4. Claims 1-11 are under consideration.

### **Rejections Withdrawn**

5. The rejection of claims 1-4, 8, 10, and 11 under 35 U.S.C. 101, nonstatutory subject matter, is withdrawn in light of applicants' arguments and the amendment of the claims.
6. The rejection of claim 11 under 35 U.S.C. 112, second paragraph, as being indefinite for variant or derivative, is withdrawn in light of the amendment of the claim.
7. The rejection of claim 10, under 35 U.S.C. 112, first paragraph, written description, is withdrawn in light of applicants' arguments.

### **Rejections Maintained**

8. The rejection of claims 1-11 under 35 U.S.C. 112, second paragraph, as being indefinite for "followed", is maintained for reasons of record.

Applicants argue that in the wild-type amino acid sequence the cysteine at position number 29 is immediately followed by the Trp Asp Lys Glu sequence and that

Art Unit: 1645

the amendment of claim 1 to recite the position of the cysteine residue obviates the rejection.

The examiner has considered applicants' argument, but does not find it persuasive for the reason of record. Newly amended claim 1 remains indefinite because the claim does not recite what applicants argue, that the cysteine at position number 29 is ***immediately*** followed by the Trp Asp Lys Glu sequence. Therefore, the actual claimed position of the Trp Asp Lys Glu sequence remains indefinite.

9. The objection to claims 1, 2, and 5-11 because the claims contain an amino acid sequence, i.e., TrpAspLysGlu, without the required sequence identifier, is maintained for reasons of record.

Applicants submitted a new sequence listing with SEQ ID NO:42 listing the amino acid sequence TrpAspLysGlu and have amended the specification to include the term "SEQ ID NO:42".

The examiner has considered applicants' argument, but does not find it persuasive because the claim does not recite "SEQ ID NO:42".

### **Sequence Listing Discrepancy**

10. The examiner has noted that a recent sequence search of SEQ ID NO:4 indicated a discrepancy between the sequence listings submitted. Clarification is needed concerning a possible new matter issue.

The sequence listing, marked as received Jan 19 2001, indicates that SEQ ID NO:4, positions 417-423 are Ile Thr Asp Ile Asn Asn Leu. Applicants written response, received the same date, recites "In SEQ ID NO:4, the carboxy-terminal sequence 'Xaa Xaa' was replaced with 'Asn Leu' to provide a translation of the terminal condons of SEQ ID NO:3. Accordingly, fields <220> to <223> are not required in SEQ ID NO:4 as

Art Unit: 1645

amended. The terminal two amino acids are described in the original specification at page 25, lines 23-26."

The sequence listing, marked as received Feb 06 2003, indicates that SEQ ID NO:4, positions 417-423 are Xaa Xaa Xaa Xaa Xaa Xaa Xaa.

The sequence listing, marked as received May 01 2003, indicates that SEQ ID NO:4, positions 417-423 are Xaa Xaa Xaa Xaa Xaa Xaa Xaa.

Please clarify: 1) what is the correct SEQ ID NO:4 listing, and 2) if it differs from the originally filed sequence listing, why this does not constitute new matter.

### **Conclusion**

11. No claims are allowed.
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. This application contains claims 18-33 drawn to a nonelected invention. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.


Art Unit: 1645

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RODNEY P. SWARTZ, PH.D.  
PRIMARY EXAMINER  
Art Unit 1645

July 14, 2004